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PATENT

APPLICANT: James V. Young.
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April 22, 2003
Date of Signature

Commissioner of Patents
Washington, DC 20231

April 22, 2003
St. Louis, Missouri

ATTENTION: Board of Patent Appeals and Interference

APPELLANT'S BRIEF (37 CFR 1.192)

This brief is in furtherance of the Notice of Appeal filed in this case on June 5, 2002.

The fees required under §1.17(f), any required petition for extension of time for filing this brief, fees associated with the revival of the application and fees therefor are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate (37 CFR 1.192(a)).

This brief contains these items under the following headings and in the order set forth below (37 CFR 1.192(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF INVENTION

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OFFICE OF PETITIONS

VI. ISSUES

VII. GROUPING OF CLAIMS

VIII. ARGUMENTS

☐ ARGUMENT: VIIIA. REJECTIONS UNDER 35 U.S.C. § 112,
FIRST PARAGRAPH

☐ ARGUMENT: VIIIB. REJECTIONS UNDER 35 U.S.C. § 112,
SECOND PARAGRAPH

☒ ARGUMENT: VIIC. REJECTIONS UNDER 35 U.S.C. § 102

☒ ARGUMENT: VIID. REJECTIONS UNDER 35 U.S.C. § 103

☐ ARGUMENT: VIIIE. REJECTIONS OTHER THAN 35 U.S.C.
§ 102, 103 AND 112

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

☐ OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY
OR DESIRABLE

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST (37 C.F.R. 1.192(c)(1))

The real party in interest in this appeal is General Physiotherapy, Inc., a Missouri corporation that has acquired the rights to the present invention by assignment from the named inventor.

II. RELATED APPEALS AND INTERFERENCES
(37 C.F.R. 1.192(c)(2))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or having a bearing on the Board's decision in this appeal:

A. [☒] there are no such appeals or interferences.

B. [☐] there are as follows:

III. STATUS OF CLAIMS (37 CFR 1.192(c)(1))

The status of the claims in this application is:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-20.

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: 8, and 10-14.
2. Claims withdrawn from consideration but not cancelled: None.
3. Claims pending: 1-7, 9 and 15-20.
4. Claims allowed: None.
5. Claims rejected: 1-7,9 and 15-20.

C. CLAIMS ON APPEAL

The claims on appeal are: 1-7, 9 and 15-20.

IV. STATUS OF AMENDMENTS (37 CFR 1.192 (c)(4))

An Office Action Response filed by the applicant on April 5, 2002, in response to the Examiner's Final Office Action of December 5, 2001 was entered by the Examiner per an Office Action dated April 26, 2002. The Examiner stated that the amendments overcame the rejections under 35 USC 112, second paragraph and would be entered for purposes of appeal, but maintained the rejections on the art.

V. SUMMARY OF INVENTION (37CFR 1.192(c)(5))

The present invention relates to the massage devices, and in particular to a device applicable to cellulite massage. The device combines mechanical oscillation, vibration and suction in a new manner, the combination of which acts in a superior way to break up fat clusters and stretch fibrous tissues by means of a combined oscillatory and/or vibratory massage in combination with strong localized suction. The physical combination of forces stretches or elongates fibrous tissue and increases blood circulation to the target area of application. The result is improved skin toning, improved elasticity and, by moving the fibers and fluids, it helps change the shape of fat compartments in the human body. The technique employed in by the device is noninvasive, and helps reduce dimpling and "orange-peel" texture appearance of the skin typical with cellulite formations. The device includes a housing having a motor the output of which is connected to a drive cable. The drive cable in turn is attached to an applicator head. The applicator head is specifically designed to provide a cavity. The cavity in the applicator head permits skin to be drawn inwardly of the cavity during device operation. A vacuum pump is associated with the housing and is connected to the applicator to impart at least a partial vacuum in the applicator thereby permitting the applicator to draw the skin into the cavity of the applicator.

VI. ISSUES (CFR 1.192(c)(6))

1. Whether Claim 1 was properly rejected under 35 U.S.C. 102 (b) as being anticipated by Holt.

2. Whether Claims 2-3 were properly rejected under 35 U.S.C. 103 (a) as being unpatentable over Holt.

3. Whether Claims 4 and 5 were properly rejected under 35 U.S.C. 103 (a) as being unpatentable for Holt in view of Howerin.

4. Whether Claims 6, 7, 9 and 15-18 were properly rejected under 35 U.S.C. 103 (a) has be unpatentable over Holt in view of Marshall et al. and Rohrer.

5. Whether Claims 19 and 20 were properly rejected under 35 U.S.C. 103 (a) as been unpatentable over Holt, in view of Marshall et. al. and Rohrer and further in view of Howerin.

VII. GROUPING OF CLAIMS (CFR 1.192(c)(7))

With respect to the 35 USC 102 (b) rejection, Claim 1 stands alone.

With respect to the 35 USC 103 (a) rejection, claims of 2-7, 9, and 15-20 are to be considered as a single group.

The various groups stand or fall separately. Within the groups, the claims stand or fall separately.

VIIIC. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 102
(CFR 1.192(c)(8)(iv))

The examiner rejected Claim 1 of the present case as being clearly anticipated by Holt. The examiner admitted that the Holt device is different from the instant invention, but claimed or argued that the claims do not define over Holt. The Examiner argues that "Figure 2 of Holt shows a massage head 10 driven by a motor through a cable 12 (figure 1). Figure 4 shows the different parts of the applicator and how it is removably mounted by the screw threads in the top of the housing at 20 onto nipple 16. The nipple 16 is tubular shaped and the portion of the applicator housing mating with nipple 16 is likewise tubular shaped. Therefore, the applicator has a connection tube integrally formed in said applicator. This tube in the applicator is also adapted to pass contaminants from the cavity to the vacuum source. While the plate 28 is adapted to stop most contaminants there will inevitably be contaminants that the plate does not stop. Moreover, if the plate is over loaded contaminants will pass around plate 28. Therefore, the tube was adapted to pass contaminants should they get past plate 28. Element 25 forms a plurality of cavities 26 permitting skin to be drawn inwardly of it. It would appear that Holt includes all of the positively recited claim limitations."

The problem with the Examiner's position is that the Examiner reads into Holt the structural limitations of applicant's claims when none of those structural components are shown, described or even vaguely intimated by the Holt specification. In fact, the Holt specification teaches the complete opposite of the position taken by the Examiner in fashioning the claim rejection. Holt states at column 2, line 57 "By using the vibrator in the ordinary manner, dead skin, black kids and other objectionable material will be loosened, while the section provided will remove the loosen material and draw the same inward through the openings 26 and 23. **The plate 28 will prevent this material from being drawn into the air passage, the said material**

being collected within the cup - shaped holder 20. The applicator 25 and shall 21 may thereafter be removed and the device thoroughly cleaned." (Emphasis supplied). The Examiner's modification and interpretation of Holt is completely contrary to what Holt recites in the specification. A reference teaches what it teaches, but the Examiner is not free to use applicant's specification as a guide and then modify the prior art in a manner contrary what that art teaches to fashion a rejection.

In addition, Holt, in Figure 3, shows an applicator which cannot possibly be used to draw and stretch the fibrous tissue of the human body within the cavity is required in Claim 1. The very construction of the applicator shown in Holt prevents that result. Again, it is respectfully suggested that the Examiner is using applicant's specification as a blue print to modify what the prior art shows and describes. After modification the Examiner uses the "new" Holt structure to fashion a rejection that is nowhere shown or suggested in the Holt reference. Because applicant's device often is used with lotions that are applied to the body, a large amount of contaminants are drawn through the applicator into applicant's device. It is respectfully suggested that the modification of Holt, for example by the removal of the plate 28 shown in Holt, makes Holt inoperable. Holt clearly believed that containments entering the motor 13 and fan 19 combination was not desirable, or else Holt would have eliminated the plate 28. In addition, the Holt applicator has a second plate 22 associated with it, and the labyrinth structure provided by that combination functions as a filter for the kind of containments Holt dealt with, i.e., "dead skin, blackheads and other objectionable material loosened" by the device. In any event, the removal of plate 28 is contrary to Holt teaches, i.e., large amounts of contaminants should not be drawn through the applicator device.

Finally, Holt was never intended the applicator shown in the drawing, and the very construction of the applicator prevents it from drawing fibrous tissue of the body inwardly of the applicator. Holt only functions to provide an applicator that is used to loosen dead skin, blackheads and the like, which is then drawn by suction into the head, "said material being collected within the cup- shape holder 20." While the motivation to modify a reference can come from the knowledge of those skilled in the art, from the prior art reference itself, or from the nature of the problem to be solved (see *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)), the only thing present here to suggest the modification here is applicant's specification. Here, the very ease with which the invention can be understood has prompted the Examiner "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (*W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Claim 1 includes the as elements the following:

an applicator removably mounted to said massage head for transferring the mechanical oscillations to the body, said applicator head further having a cavity formed in an end surface of the applicator for permitting skin to be drawn inwardly of the cavity, the cavity being substantially the size of the end surface, and a connection tube formed in said applicator, said tube communicating with said cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity, said connection tube being removable with said applicator and adapted to pass contaminants from the cavity;

a connection between said vacuum pump and said applicator to impart at least a partial vacuum in the cavity of the applicator so that placement of the head on a human body results in

the application of a force combination of mechanical oscillation and suction, said connection including a suction line carried externally of said drive cable, said suction line having a first end operatively connected to said vacuum pump and a second end operatively attached to said connector tube, said connection tube drawing contaminants from the cavity through said connection tube.

Neither of these elements are shown in their entirety by the Holt reference as required by 35 U.S.C.102. First, the cavity is "substantially the size of the end surface" and the partial vacuum must "draw and stretch the fibrous tissue of the human body within the cavity." As indicated above, neither of these terms is met by the Holt reference. Second, applicant's device is intended to have a connection tube which draws " contaminants from the cavity through said connection tube." Holt's specification describes a structure which specifically prevents this action.

All the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). It is improper for the Examiner to fashion a rejection by modifying a reference so that the reference, after modification, reads on applicant's claims. But that is precisely what the examiner has done in the present case. Reversal of the 35 USC 102 rejection is respectfully requested.

Claims 2-6, 7 and 9 each depend either directly or indirectly from independent Claim 1, which is seen as allowable in view of the discussion above. Accordingly, since these dependent claims merely add additional limitations to independent Claim 1, they are seen as patentable under 35 U.S.C. § 103(a) over the references of record for the same reasons as Claim 1. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

VIIID. ARGUMENTS – REJECTIONS UNDER 35 USC 103 (a).

Independent Claim 15 is not shown by the art relied upon by the Examiner, and is not obvious from that art. Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Holt in view of Marshall et al and Rohrer. Claim 15 includes the following claim elements not shown in the art :

an applicator removably mounted to the massage head, said applicator having a concave shaped cavity formed in an end surface of it, and a connection tube attached to said applicator head in operative communication with the cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue within substantially the entire cavity, the cavity having a size about the size of the end surface;

a vacuum line connected between the connection tube of the applicator and the vacuum pump, said vacuum line drawing contaminants from the cavity through said connection tube;

Again, Holt does not disclose a system in an applicator has a concave shaped cavity formed in an end surface in which fibrous tissue is drawn and stretched within substantially the entire cavity, the cavity having a size about the size of the end surface. Marshall and Rohrer do not supply the deficiencies of Holt. Marshall is a device for stimulating the human scalp, the stated purpose of which is to promote the growth of human hair. Marshall fits over the scalp. It in not way draws and stretches fibrous tissue within substantially the entire cavity. Rohrer is another dandruff removing device adapted to be used in conjunction with the hose of a vacuum cleaner. Rohrer does not show or suggest structure which draws and stretches fibrous tissue within substantially the entire cavity.

Without intending to be repetitious, Claim 15 (and claim 1) requires an applicator having an end surface, the applicator having a concave shape cavity formed in that end surface. In addition, the cavity is defined as having a size this substantially the size of the end surface of the applicator. Applicant's invention is a device that is useful in body massage and in particular, useful and the reduction of cellulite in the human body. In order to perform that function, relatively large portions of the body are worked. As indicated above, Holt's applicator prevents large portions of anything being drawn internally of the applicator. Holt, in figure 2, shows an applicator that cannot possibly be used to draw stretch the fibrous tissue of the human body within the cavity as required in Claim 15. Claim 15 further requires that the connection to element be capable of applying at least a partial vacuum to the cavity in the applicator so as to draw and stretch fibrous tissue of the human body into the cavity. The construction of the applicator shown in Holt and Rohrer prevents a similar result from happening. As also indicated above, Holt has a plurality of projections 25 which prevent large areas of the human body either from being drawn into the cavity as required by applicant's claims, or from being useful in the kind of a massage that applicant's invention provides. Rohrer has a plurality of massaging nodules 16 which prevent the same thing. While Marshall shows a large open mouth device, the device is fitted to the head. Nowhere does Marshall show or suggest the ability to draw the human head, or any other part of the human body, into the applicator as required by the claims of the present invention. As the Federal Circuit has repeatedly stated, the genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the

case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher). Applicant has devised a unique and unobvious combination of elements finding use in cellulite care through massage therapy. The art relied upon by the Examiner is devoid of any mention structure as set out in the claims, whether that art is considered singly or in combination.

Reversal of the Examiner's rejection of Claim 15 is respectfully requested.

Claims 16-20 each depend either directly or indirectly from independent Claim 15, which is seen as allowable in view of the discussion above. Accordingly, since these dependent claims merely add additional limitations to independent Claim 15, they are seen as patentable under 35 U.S.C. § 103(a) over the art for the same reasons as Claim 15. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

IX. APPENDIX OF CLAIMS (37 CFR 1.192(c)(9))

The text of the claims in the appeal are:

1. A massage apparatus for massaging a human body, comprising:
 - a housing;
 - a motor associated with said housing;
 - a drive cable operatively connected to said motor;
 - a massage head driven by said motor through said cable, said motor imparting mechanical oscillations to said massage head;
 - an applicator removably mounted to said massage head for transferring the mechanical oscillations to the body, said applicator head further having a cavity formed in an end surface of the applicator for permitting skin to be drawn inwardly of the cavity, the cavity being substantially the size of the end surface, and a connection tube formed in said applicator, said tube communicating with said cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue of the human body within the cavity, said connection tube being removable with said applicator and adapted to pass contaminants from the cavity;
 - a vacuum pump associated with said housing; and
 - a connection between said vacuum pump and said applicator to impart at least a partial vacuum in the cavity of the applicator so that placement of the head on a human body results in the application of a force combination of mechanical oscillation and suction, said connection including a suction line carried externally of said drive cable, said suction line having a first end operatively connected to said vacuum pump and a second end operatively attached to said connector tube, said connection tube drawing contaminants from the cavity through said

connection tube.

2. A massage apparatus of claim 1 further including a speed control associated with said housing for controlling the speed of the motor.

3. The massage apparatus of claim 1 further including at least one collection vile operatively associated with the vacuum line for removing contaminants in the vacuum line.

4. The apparatus of claim 3 further including a second vile for collecting air born containment's operatively associated in said vacuum line.

5. The apparatus of claim 4 wherein said [valves] viles are removably mounted to the apparatus.

6. The apparatus of claim 1 further including a control device to permit suction and vibration to be used independently of one another.

7. The apparatus of claim 6 wherein said applicator is removably mounted to said massage head.

8. Cancelled.

9. The apparatus of claim [8] 7 wherein said vacuum connection is attached [as an] to said applicator by quick connect device.

10-14 Cancelled.

15. A therapy massage device comprising:

a housing;

a motor mounted to the housing;

a vacuum pump mounted to the housing;

a drive cable operatively connected to the motor;

a massage head operatively driven by the cable;

an applicator removably mounted to the massage head, said applicator having a concave

shaped cavity formed in an end surface of it, and a connection tube attached to said applicator head in operative communication with the cavity, said connection tube capable of applying at least a partial vacuum to the cavity so as to draw and stretch fibrous tissue within substantially the entire cavity, the cavity having a size about the size of the end surface;

a vacuum line connected between the connection tube of the applicator and the vacuum pump, said vacuum line drawing contaminants from the cavity through said connection tube; and

a control system mounted to the housing which is selectively operated to provide suction and vibration to the body through the applicator head.

16. The device of claim 15 wherein said control system includes a control for varying the speed of the motor.

17. The device of claim 16 further including at least one filter operatively associated with the vacuum line 51.

18. The device of claim 17 wherein said filter is removably mounted from the device.

19. The device of claim 18 further including a second filter operatively associated with the vacuum line.

20. The device of claim 19 wherein said first and second filters are replaceable.

Respectfully submitted,



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